

REMARKS

Before entry of this Amendment and Response, the status of the application according to the pending Office action is as follows:

- Claims 3 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.
- Claims 1-14, 18-20, 22-28, 30-32, and 34-35 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,717,183 to Brenner (hereinafter “Brenner”).
- Claims 1-14, 18-20, 22-28, 30-32, and 34-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,082,309 to Turiansky (hereinafter “Turiansky”).
- Claims 22-28 and 30-31<sup>1</sup> are rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent No. DE 9208875.9 to Hsing (hereinafter “Hsing”).
- Claims 22-31 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,871,420 to Shikhashvili (hereinafter “Shikhashvili”).
- Claims 32 and 33 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,086,572 to Lee (hereinafter “Lee”).
- Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over any of Shikhashvili, Hsing, Turiansky, or Brenner.

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<sup>1</sup> The Office action indicates that claims 20, 22-28, and 30-31 are rejected under 35 U.S.C. § 102(b) to Hsing, but also notes “[t]he rejection with regard to claims 1, 32 and claims that depend therefrom have been withdrawn in view of the amendment.” Office action at 3. Accordingly, it is Applicants’ understanding that the rejection of claim 20 was in error, as claim 20 depends directly from claim 1. Accordingly, Applicant’s do not address the rejection of claim 20 under Hsing in this paper. Should Applicants’ belief be in error, Applicants respectfully reserve their right to argue the patentability of claim 20 with regard to Hsing.

- Claims 21 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the references Hsing or Turiansky or Brenner as applied to claims 20 and 28 above, and further in view of U.S. Patent No. 1,974,456 to Goldzweig (hereinafter “Goldzweig”).

Applicants appreciate the Examiner’s courtesy in granting Applicants’ representatives the telephonic interview held on May 22, 2006, and the helpful comments and suggestions of the Examiner. The amendments and remarks set forth herein are consistent with those discussed during the interview. Applicants respectfully submit that this paper serves as the Applicants’ statement of the substance of the interview in accordance with 37 C.F.R. § 1.133(b).

With this Amendment and Response, Applicants hereby amend claims 1, 3, 5, 22, and 32, without prejudice. Support for the amendments may be found in the specification as filed, and at least in paragraphs [0019] - [0022], [0024], [0025], [0029], [0031]; and FIGS. 1, 2A, 2B, 3, and 6. No new matter has been added thereby.

In view of the above amendments and following remarks, Applicants respectfully request reconsideration and withdrawal of all grounds of rejection and passage of claims 1-35 to allowance in due course.

1. Claims 3 and 5 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully traverse this rejection as applied to the claims as amended.

Applicants respectfully submit that the orientation of the guiding surface with respect to the ground engaging surface and during the greatest relative velocity phase of the step cycle are disclosed in the application as filed, at least at FIGS. 2A and 3, and in the specification at least at

paragraphs [0021] and [0024]. FIG. 2A indicates the orientation of the guiding surface (depicted by angle  $\beta$ ) relative to the ground engaging surface of the shoe. FIG. 3 depicts angle  $\beta$  as substantially horizontal when the shoe is in a position after push-off.

As such, claims 3 and 5 are definite and comply with the requirements of 35 U.S.C. § 112, second paragraph. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection of amended claims 3 and 5 under 35 U.S.C. § 112, second paragraph.

2. Claims 1-14, 18-20, 22-28, 30-32, and 34-35 are rejected under 35 U.S.C. §102(b) as being anticipated by Brenner. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Brenner appears to describe a forward portion of an upper of a shoe comprising a plurality of sections that include a series of substantially parallel slits forming members 11. A strip 10 is passed over and under the members 11 through the slits in such a manner that the members 11 are deflected transversely relative to each other, producing the effect of a twisting of such members 11 and providing an ornamental and attractive appearance for the surface of the forward portion of the upper. A cross section of an exemplary ornamental portion of Brenner is depicted in FIG. 3. As depicted in the figure, the edges of the members 11, appear to be relatively square or rectangular in shape. The corners of each member appear to be right angles.

In contrast, Applicants' amended independent claim 1 recites a shoe including a ventilation system comprising “*a substantially rigid frame* extending along an edge of the opening” and a guiding surface “*extending generally outward* from a longitudinal axis of the shoe, wherein the guiding surface comprises . . . a *leading edge oriented generally forward* of the guiding surface, relative to a heel of the shoe, wherein the *guiding surface is adapted to*

*redirect an airflow into the opening* under a movement of the shoe.” Brenner appears to lack such structure. First, Brenner does not appear to disclose a “substantially rigid frame” of any sort; the members 11 forming the ornamental panel are entirely integral with the material of the shoe upper. Second, as depicted in FIG. 3, the members 11 appear as generally thin strips, with little, if any, “guiding surface . . . adapted to redirect an airflow into the opening.” Even if the members 11 could be considered guiding surfaces, which they can not, none of the members 11 appear to have “a leading edge oriented generally forward of the guiding surface.” In fact, the edges of each member 11 do not appear to extend any farther than the surface itself, due apparently, at least in part, to their orientation and squared corners.

In contrast, Applicants depict a first embodiment in FIG. 2B where the “leading edge [is] oriented generally forward of the guiding surface.” Relative to the heel of the shoe, the leading edges of the guiding surfaces are forward of the guiding surface. Applicants respectfully suggest that nowhere in Brenner’s figures or specification is such a configuration disclosed.

Accordingly, Applicants respectfully submit that amended claim 1 is not anticipated by Brenner.

Applicants’ amended independent claims 22 recites a shoe including a ventilation system, the ventilation system comprising, *inter alia*, at least, a leading edge “*oriented generally forward* from the guiding surface, relative to a heel of the shoe, and wherein the ventilation channel is adapted to direct airflow into . . . the inlet.” In addition, Applicants’ amended independent claim 22 recites an inlet, an outlet, and “*at least two guiding surfaces defining a ventilation channel therebetween in fluid communication with the inlet*.” For the reasons presented with regard to claim 1 above, Applicants respectfully submit that Brenner does not disclose a leading edge “*oriented generally forward* from the guiding surface, relative to a heel of the shoe, and wherein

the ventilation channel is adapted to direct airflow into . . . the inlet.” Additionally, the upper taught by Brenner does not include an outlet and a ventilation channel in fluid communication with an inlet; indeed, it does not include a ventilation channel of any sort. Rather, Brenner merely teaches a method of forming a decorative pattern into the upper of a shoe. No particular ventilation system, including an inlet and an outlet, is provided. Accordingly, Applicants respectfully submit that amended claim 22 is not anticipated by Brenner.

Applicants’ amended independent claims 32 recites a shoe including a ventilation system, the ventilation system comprising, *inter alia*, “at least one vane **bridging the at least one opening**” and “a guiding surface comprising a leading edge, wherein the **leading edge is oriented generally forward of the guiding surface**, relative to a heel area of the shoe, and wherein the guiding surface extends generally outward from the longitudinal axis so as to redirect an airflow into the at least one opening.” Applicants respectfully submit that Brenner does not disclose a vane bridging an opening, but rather discloses a series of slits in the material of a section of a shoe producing a number of strips of material. A further strip of material is woven through the strips to produce a decorative pattern on the section. A number of small openings are produced by the woven material, with each strip defining the boundaries of each small opening. As such, Brenner does not teach or suggest a guiding surface or vane “bridging [an] opening,” but merely describes a series of strips defining the boundaries of the ornamental holes in the shoe. In addition, Applicants respectfully submit that Brenner does not disclose a “leading edge” structure for the reasons presented with regard to claim 1, above. Accordingly, Applicants’ respectfully submit that amended claim 32 is not anticipated by Brenner.

Applicants respectfully submit that amended independent claims 1, 22, and 32 are

patentable in view in Brenner. Because claims 2-14, 18-20, and 34-35 depend, either directly or indirectly, from the amended claims, and include all of the limitations thereof, Applicants respectfully submit these claims are patentable as well. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-14, 18-20, 22-28, 30-32, and 34-35 under 35 U.S.C. §102(b) based on Brenner.

3. Claims 1-14, 18-20, 22-28, 30-32, and 34-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Turiansky. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Turiansky appears to describe a shoe upper including a number of outer strips 1, cross strips 2, and a backing 3. The backing is cut to provide apertures 4. The outer strips 1, cross strips 2, and the backing 3 are firmly held together by stitching 5. The outer strips 1 and cross strips 2 can be diagonally assembled, or cross at right angles. Similar to Brenner, a cross section of an exemplary portion of Turiansky is depicted in FIGS. 3 and 6. As depicted in the figures, the edges of the strips 1, 2 appear to be relatively square or rectangular in shape, and to share a common contour with the backing 3 that forms the shoe upper.

In contrast, Applicants' amended independent claim 1 recites a shoe including a ventilation system comprising “*a substantially rigid frame* extending along an edge of the opening” and a guiding surface “*extending generally outward* from a longitudinal axis of the shoe, wherein the guiding surface comprises . . . a *leading edge oriented generally forward* of the guiding surface, relative to a heel of the shoe, wherein the *guiding surface is adapted to redirect an airflow into the opening* under a movement of the shoe.” Applicants respectfully submit that Turiansky does not disclose a substantially rigid frame. The apertures 4 in Turiansky

are formed through the very backing 3 that appears to form the shoe upper, and each aperture 4 does not appear to have a “substantially rigid frame” extending along an edge. Also, as depicted in FIGS. 3 and 6, the strips 1, 2 appear as generally thin strips, with little, if any, “guiding surface . . . adapted to redirect an airflow into the opening.” Moreover, even if the strips 1, 2 could be considered a guiding surface, which they can not, none of the strips 1, 2 appear to have “a leading edge oriented generally forward of the guiding surface.” The strips 1, 2 of Turiansky do not appear to have any edge that leads a guiding surface, in fact, the edges of each surface do not appear to extend any farther than the surface itself.

Applicants, however, depict a first embodiment in FIG. 2B where the “leading edge [is] oriented generally forward of the guiding surface.” Relative to the heel of the shoe, the leading edges of the guiding surfaces are forward of the guiding surfaces. Applicants respectfully suggest that nowhere in Turiansky’s figures or specification is such a configuration disclosed. Accordingly, Applicants respectfully submit that amended claim 1 is not anticipated by Turiansky.

Applicants’ amended independent claims 22 recites a shoe including a ventilation system, the ventilation system comprising, *inter alia*, at least, an inlet, an outlet, and “***at least two guiding surfaces defining a ventilation channel therebetween in fluid communication with the inlet.***” Additionally, the claim recites a leading edge “***oriented generally forward*** from the guiding surface, relative to a heel of the shoe, and wherein the ventilation channel is adapted to direct airflow into . . . the inlet.” For the reasons presented with regard to claim 1 above, Applicants respectfully submit that Turiansky does not disclose a leading edge “***oriented generally forward*** from the guiding surface, relative to a heel of the shoe, and wherein the

ventilation channel is adapted to direct airflow into . . . the inlet.” Additionally, the upper taught by Turiansky does not include an outlet and a ventilation channel in fluid communication with an inlet; indeed, it does not include a ventilation channel of any sort. Rather, Turiansky merely teaches a method of forming a decorative pattern into the upper of a shoe. No particular ventilation system, as claimed in amended claim 22, including an inlet, a ventilation channel in communication with the inlet, and an outlet, is provided. Accordingly, Applicants respectfully submit that amended claim 22 is not anticipated by Turiansky.

Applicants’ amended independent claims 32 recites a shoe including a ventilation system, the ventilation system comprising, *inter alia*, “at least one vane **bridging the at least one opening**” and “a guiding surface comprising a leading edge, wherein the **leading edge is oriented generally forward of the guiding surface**, relative to a heel area of the shoe, and wherein the guiding surface extends generally outward from the longitudinal axis so as to redirect an airflow into the at least one opening.” Applicants respectfully submit that Turiansky does not disclose a vane bridging an opening, but rather discloses a shoe having an overlapping open work in the uppers. As such, Turiansky does not teach or suggest a guiding surface or vane “bridging [an] opening,” but merely describes a series of strips defining the boundaries of the ornamental holes in the shoe. In addition, Applicants respectfully submit that Turiansky does not disclose a leading edge structure for the reasons presented with regard to claim 1, above. Accordingly, Applicants’ respectfully submit that amended claim 32 is not anticipated by Turiansky.

Applicants respectfully submit that amended independent claims 1, 22, and 32 are patentable in view in Turiansky. Because claims 2-14, 18-20, and 34-35 depend, either directly or indirectly, from the amended claims, and include all of the limitations thereof, Applicants

respectfully submit these claims are patentable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-14, 18-20, 22-28, 30-32, and 34-35 under 35 U.S.C. §102(b) based on Turiansky.

4. Claims 22-28 and 30-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hsing. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Hsing appears to describe a roller skate shoe including a liner 1 and an outer shoe 2. The liner 1 is composed of a soft material and is made to correspond to the shape of a human foot, and can include a multiplicity of air vents 11 in order to achieve moisture and temperature functions. The outer shoe 2 is made from rigid plastic or rubber and can include ankle guards 211 and cuneiform bone protectors 23 to serve as protection for the ankle and cuneiform bone of a wearer. The ankle guards 211 and cuneiform bone protectors 23 can include a multitude of air vents to provide ventilation.

Applicants' amended independent claim 22 recites "at least two guide surfaces defining a ventilation channel therebetween in fluid communication with the inlet, wherein at least a portion of at least one of the at least two guiding surfaces comprises a leading edge, the *leading edge oriented generally forward from the guiding surface* relative to a heel of the shoe, and wherein the ventilation channel is adapted to direct an airflow into a lower portion of the inlet."

Applicants respectfully submit that Hsing does not disclose such a structure. The roller skate shoe taught by Hsing does not include an outlet and a ventilation channel in fluid communication with an inlet, and further does not include a ventilation channel adapted to direct an airflow into the lower portion of an inlet. Rather, Hsing merely appears to teach a roller skate including protection for the ankle bone and cuneiform bone, wherein these protection elements include

holes to allow ventilation of these regions. No particular ventilation system, including an inlet and an outlet, is provided.

Moreover, should the ankle bone protections be considered “guiding surfaces,” which they can not be, they do not include a “leading edge oriented generally forward from the guiding surface relative to a heel of the shoe.” It appears from Hsing, FIG. 1, that the structure of the ankle bone protectors extend generally rearward. As these protectors appear to be somewhat rounded, there is no defined leading edge. Moreover, if there is a leading edge, it extends along the length of the “guiding surface” from the front of the boot towards the rear of the boot. Accordingly, it does not define a “leading edge,” as that structure is claimed in Applicants’ amended claim 22.

Accordingly, Applicants respectfully submit that amended independent claim 22 is patentable in view in of Hsing. Because claims 23-28 and 30-31 depend, either directly or indirectly, from the amended claim, and include all of the limitations thereof, Applicants respectfully submit these claims are allowable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 22-28 and 30-31 under 35 U.S.C. §102(b) based on Hsing.

**5.** Claims 22-31 are rejected under 35 U.S.C. § 102(e) as being anticipated by Shikhashvili. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Shikhashvili appears to describe a water shoe including swimming elements. The shoe includes a sole 1, an upper 4 with a perforated side wall 7 with outlet holes 6, and a number of angle shaped fins 3. The fins 3 are motionlessly fixed on the upper body 2 of the swimming shoe to provide a promotional force during swimming. Remote from the stiff console

(a), where the fin 3 is connected to the body 2, the fin 3 is flexible (c), especially at the forward edge. The perforated side wall 7 with outlet holes 6, along with holes in the sole 1, allow water and sand to drain from the shoe.

In contrast, Applicants' amended independent claim 22 recites "at least two guide surfaces defining a ventilation channel therebetween in fluid communication with the inlet, wherein at least a portion of at least one of the at least two guiding surfaces comprises a leading edge, the *leading edge oriented generally forward from the guiding surface* relative to a heel of the shoe, and wherein the ventilation channel is adapted to direct an airflow into a lower portion of the inlet." Applicants respectfully submit that Shikhashvili does not disclose such a structure, but rather merely discloses a shoe including fins fixed on regions of the upper next to outlet holes. The fins are configured to provide stability and force to a swimmer, while the outlet holes are configured to allow water and sand to flow out of the shoe. Indeed, the fins do not appear to form a "ventilation channel . . . adapted to direct an airflow into a lower portion of the inlet." Instead, the fins 7 push water (and could presumably push air on dry land), but due to the flexible (c) front edge, it appears that the structure disclosed would not move any fluid in the manner claimed by the Applicants in amended claim 22. As the water or air moves along the side of the shoe, the flexible fins would deflect at least slightly, but due to their orientation, could not direct any fluid into the lower portion of the inlet, as claimed. Applicants respectfully assert that the structure recited in amended claim 22 makes this distinction over Shikhashvili clear.

Applicants respectfully submit that amended independent claim 22 is patentable in view of Shikhashvili. Because claims 23-31 depend, either directly or indirectly, from the amended claim, and include all of the limitations thereof, Applicants respectfully submit these claims are

allowable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 22-31 under 35 U.S.C. §102(b) based on Shikhashvili.

6. Claims 32 and 33 are rejected under 35 U.S.C. § 102(b) as being unpatentable over Lee. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Lee appears to disclose a ventilated shoe having an air-flowing member 20 that appears to aid in ventilating the foot. The member 20 includes a number of outlet apertures 13 to allow air from the inside of the shoe, via the air discharge aperture 16, to escape to the outside. The entire member 20 appears to be located within an interior of the shoe, and does not extend outside the shoe.

In contrast, Applicants claim, in amended claim 32, a shoe comprising a ventilation system, comprising “a guiding surface comprising a leading edge, wherein the *leading edge is oriented generally forward of the guiding surface*, relative to a heel area of the shoe, and wherein the guiding surface extends generally outward from the longitudinal axis so as to redirect an airflow into the at least one opening.” The Office action appears to equate the struts between the outlet apertures 13 with the claimed vanes. Even if these were considered vanes, which Applicants respectfully submit is not proper, these struts are not “oriented generally forward of the guiding surface, relative to a heel area of the shoe.” Instead the struts extend directly from the side of the shoe, and the leading edges thereof do not appear to be oriented forward at all. Moreover, the very fact that the member 20 is located within the interior of the shoe prevents the member 20 from “redirect[ing] an airflow into the at least one opening.” Indeed, the airflow in Lee is depicted as moving outward from the interior of the shoe. See FIG. 14.

Accordingly, Applicants respectfully submit that amended independent claim 32 is

patentable in view in Lee. Because claim 33 depends, either directly or indirectly, from the amended claim, and includes all of the limitations thereof, Applicants respectfully submit this claims is patentable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 32 and 33 under 35 U.S.C. §102(b) based on Lee.

7. Claims 7 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over any of Shikhashvili, Hsing, Turiansky, or Brenner. Applicants respectfully traverse this rejection as applied to the claims, as amended.

As described above, Shikhashvili, Hsing, Turiansky, and Brenner all fail to teach or suggest at least one structural element of amended independent claim 1, from which claims 7 and 10 ultimately depend. At a minimum, the cited references do not teach or suggest a “leading edge oriented generally forward from the guiding surface relative to a heel of the shoe,” as claimed in claim 1; therefore, claims 7 and 10 are patentable for at least the same reasons as amended claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 7 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Shikhashvili, Hsing, Turiansky, or Brenner.

8. Claims 21 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the references Hsing or Turiansky or Brenner as applied to claims 20 and 28 above, and further in view of Goldzweig. Applicants respectfully traverse this rejection as applied to the claims, as amended.

Briefly, Goldzweig appears to describe a shoe 4 having an outersole 5, an innersole 6 and a sock lining 7. A number of holes or perforations 8 are provided in the sole of the shoe and are bushed by rivets 9. The holes or perforations 8 permit the unobstructed passage of air through

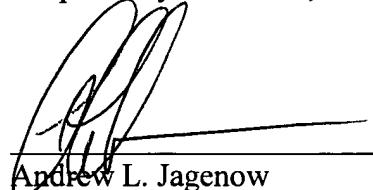
the shank of the shoe and into and out of the shoe when the wearer is in motion.

Applicants respectfully submit that the disclosure of Goldzweig fails to cure the deficiencies of Hsing or Turiansky or Brenner with respect to amended independent claims 1 and 22, as described above. As Goldzweig appears to describe a shoe having holes or perforations in the sole, it fails to cure the deficiencies of the cited references with regard to a “leading edge oriented generally forward from the guiding surface relative to a heel of the shoe,” as claimed in claims 1 and 22. As claims 21 and 29 ultimately depend from those claims, Applicants respectfully submit that they are patentable as well. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 21 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Hsing or Turiansky or Brenner as applied to claims 20 and 28 above, and further in view of Goldzweig.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection, and allowance of claims 1-35 in due course. The Examiner is invited to contact Applicants' undersigned representative by telephone at the number listed below to discuss any outstanding issues.

Respectfully submitted,



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